

**REMARKS**

Issues raised in the Office Action are addressed below in the order they were raised by the Examiner.

**Rejection of Claims 2, 9-12, 16, 20, and 24-25 under 35 USC § 103(a)**

The Examiner has continued to reject claims 2, 9-12, 16, 20, 24 and 25 under 35 USC § 103(a) as allegedly being unpatentable over Uchida et al. (U.S. Pat. No. 6,150,092) in view of Robinson et al. (5,814,620; 5,710,136; and 5,801,156).

Applicants respectfully traverse. The rejection rests on the examiner's erroneous conclusion that Uchida would motivate one of ordinary skill in the art to test a myriad of probes within the region corresponding to Uchida's SEQ ID NO:7 so as to arrive at the presently claimed probes, and, further to modify those probes for use in vivo (*e.g.*, by introducing phosphorothioate moieties). The examiner states, "One in the art would clearly have had motivation to make the instantly claimed antisense molecules since it is absolutely clear that the region targeted has been clearly shown by the prior art to be a desired target for antisense inhibition of VEGF." Yet, the examiner's position relies on the unfounded conclusion that Uchida presents data that would be persuasive to one of ordinary skill in the art. The examiner cites only one document to support his position: Uchida itself. Applicants note that Uchida is a patent and the specification and the interpretation of the data was prepared by the applicants for patent rights. Thus, it is to be expected that Uchida would portray its own data in a positive light. Applicants request that the examiner reconsider the credibility of Uchida.

Applicants have now filed two declarations by experts in the field: Dr. Parkash Gill and Dr. Ruiwen Zhang. Dr. Gill is an inventor on the present application. Dr. Zhang is, to applicants' knowledge, an entirely independent expert. Both experts conclude and declare that Uchida's data actually shows that the tested probes of Uchida et al. are *not effective* for inhibiting VEGF expression in cells.

In dismissing these two expert declarations, the Examiner states, "Applicant is directed to column 25 and 26 of Uchida et al. Uchida et al. disclose that the oligonucleotide shown in Table 9 are in fact considered effective..." The Examiner dismisses the

Declarations of Gill and Zhang as mere opinion, and yet Applicants note that Uchida's characterization of his own data is also merely opinion. Gill, Zhang, and Uchida have all looked at the data presented and reached different conclusions. The examiner must decide which evidence is more credible. Applicants note that it is common for examiners to dismiss as per se not credible the declarations of inventors pertaining to the patentability of their own inventions. Uchida's interpretations of his own data presented in an application for patent should be viewed with the same suspicion. By contrast, Applicant is not aware that Dr. Zhang has any interest one way or the other in the outcome of the present prosecution. Therefore, Applicants request that the Examiner reconsider the credibility of the evidence before him.

The Examiner has repeatedly requested data comparing the effectiveness of probes disclosed by Uchida to those claimed in the present application. Applicants note that comparative data is not a requirement for patentability in a case, such as this, where the examiner has failed to make a prima facie case of obviousness. On the facts presented to Applicants through the Declarations of Drs. Gill and Zhang, Uchida's data would tend to discourage one of ordinary skill in the art from developing antisense probes against the region of SEQ ID NO:7, because the skilled artisan would conclude that such probes had been ineffective. Uchida, by in fact demonstrating the ineffectiveness of probes targeted to SEQ ID NO:7, teaches away from the development of the claimed probes.

The weight of evidence clearly supports Applicants' position. Accordingly, reconsideration and withdrawal of the rejection under 35 USC § 103(a) are respectfully requested.

The other rejections under section 103 would be overcome for the same reasons.


**CONCLUSION**

Applicants respectfully request reconsideration and withdrawal of the pending rejections. Applicants believe that the claims are now in condition for allowance and early notification to this effect is earnestly solicited. Any questions arising from this submission may be directed to the undersigned at (617) 951-7000. If there are any other fees due in connection with the filing of this submission, please charge the fees to our **Deposit Account No. 18-1945**, under **VASG-P02-003**.

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Respectfully Submitted,



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